

### REMARKS / ARGUMENTS

The present application includes pending claims 1-39, all of which have been rejected. The Applicant respectfully submits that the claims define patentable subject matter.

Initially, the Applicant notes that a goal of patent examination is to provide a prompt and complete examination of a patent application.

It is essential that patent applicants obtain a prompt yet complete examination of their applications. Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application, even if one or more claims are found to be deficient with respect to some statutory requirement. Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action. Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

See Manual of Patent Examining Procedure (MPEP) § 2106(II). As such, the Applicant assumes, based on the goals of patent examination noted above, that the present Final Office Action has set forth "all reasons and bases" for rejecting the claims.

Claims 1-28 stand rejected under 35 U.S.C. § 102(a) as being anticipated by US Patent Publication No. 2002/0042778, issued to Nel (hereinafter, Nel). The Applicant respectfully traverses these rejections at least for the reasons previously set forth during prosecution and at least based on the following remarks.

## RESTRICTION REQUIREMENT

The Final Office Action states the following regarding the Restriction Requirement:

Newly submitted claims 29-39 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 1-28 are drawn to a system for providing billing support and securing payment for delivery of media. Claims 29-39 are drawn to a communication channel for selecting media content for consumption for times scheduled by a first user.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 23-39 are withdrawn from consideration as being directed to a non-elected invention.

See the Final Office Action at page 2. This restriction requirement is respectfully traversed because "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." MPEP § 803. One of the "two criteria for a proper requirement for restriction between patentably distinct inventions" is that "[t]here must be a serious burden on the examiner if restriction is not required . . . ." MPEP § 803 (emphasis added). While "[f]or purposes of the initial requirement a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search . . . [t]hat prima facie showing may be rebutted by appropriate showings or evidence by the applicant." MPEP § 803 (emphasis added). The applicant rebuts the Examiner's prima facie showing in this case as follows.

The fields of search required to search the respective systems and circuits are essentially coextensive. For example, as previously stated in the July 20, 2006 response, the circuit of claims 29-39 is similar in many respects to the system of claims 1-28.

A proper search of the system claims has already required the Examiner to search for patents classified in the respective arts. Because prior patents disclosing and claiming both systems and circuits have issued, the systems and circuits have not acquired a separate status in the art. Naturally, the Examiner did not know what art would be found and cited before making the restriction requirement. The fact that consideration and citation of circuits prior art turned out to be necessary should change the initial decision that a serious burden would result unless restriction between the system and circuit claims was required.

For these reasons, examining both system and circuit claims in the same application does not present a serious burden in this instance. The restriction requirement should therefore be withdrawn.

#### **THE EXAMINER'S "RESPONSE TO ARGUMENTS" SECTION IN THE FINAL OFFICE ACTION**

The Applicant points out that in her "Response to Arguments" Section, the Examiner is rebutting the Applicant's arguments regarding claims 1, 12, and 23 using

the same single citation from Nel (pages 3-4, paragraphs 51 and 53), which was used in her April 20, 2006 Office Action.

In response to Applicant's argument with regard to independent claims 1 and 23, the Examiner states:

Nel discloses a user interface having at least one user defined media channel where the at least one user defined media channel comprises a sequence of user selected and scheduled media (user may select products from a service provider, such as access to a broadcast channel, for example a movie or documentary programming, and real time accounting and payment may be made for the service p. 3-4, 51 and p.4, 53).

See the Final Office Action at page 3. In her remarks with regard to claims 1 and 23, *it is unclear what the Examiner is referring to by citing paragraphs 51 and 53, since neither of these paragraphs, nor any of the remaining paragraphs of Nel, teach a "user interface having at least one user defined media channel comprising a sequence of user selected and scheduled media," as recited by the Applicant in claim 1. More specifically, even though Nel discloses access by a user to a broadcast channel, Nel does not disclose a media channel where the user may select and schedule media. In fact, Mel does not disclose any media scheduling whatsoever.* Similarly, the Examiner has not demonstrated where in Nel it is disclosed or suggested a server for storing the media and server software running on the server and receiving a request for the delivery of media, as recited by the Applicant in claims 1 and 23.

In response to Applicant's argument with regard to independent claim 12, the Examiner states:

Nel discloses storage in a home, where the storage supports media consumption and has an associated protocol address (the requested product or service is delivered to the user for viewing on the television screen by way of satellite and Internet communication and a database that supports media consumption and has an associated protocol address p.3-4, 51 and p.4, 53).

See the Final Office Action at page 4. In her remarks with regard to claim 12, *it is unclear what the Examiner is referring to by citing paragraphs 51 and 53, since neither of these paragraphs, nor any of the remaining paragraphs of Nel, teach a "a first storage in the first home, the first storage supporting media consumption, and having an associated first protocol address," as recited by the Applicant in claim 12. More specifically, even though Nel discloses that "the requested product or service is delivered to the user for viewing on the television screen by way of satellite and Internet communication," Nel does not disclose any storage at user home location, where the storage supports media consumption and has an associated protocol address. The Applicant further notes that the database 153 of Nel is part of the service provider computer network 152 and it is not storage at the user's home location, nor does Nel disclose that the database 153 supports media consumption or has an associated protocol address.* Similarly, the Examiner has not demonstrated where in Nel it is disclosed or suggested a user interface with a media channel with user selected and scheduled media, a server for storing the media and server software running on the server and receiving a request for the delivery of media, as recited by the Applicant in claim 12.

Therefore, the Applicant maintains the arguments submitted in the July 20, 2006 Response.

**REJECTION UNDER 35 U.S.C. § 102**

Regarding claim 1, the Applicants respectfully submit that Nel does not teach, suggest, or disclose, for example, a system providing billing support for the exchange of media, the system comprising a first television display in a first home of a first user; a first storage in the first home, the first storage supporting media consumption by the first television display in the first home, and having a first network protocol address; a user interface, at the first home, having at least one user defined media channel, each of the at least one user defined media channel comprising a sequence of user selected and scheduled media, the user interface supporting selection and scheduling of the media; at least one server storing the media, and having a second network protocol address; and server software that receives from the first home via a communication network a request for the delivery of media, the request comprising information securing payment for delivery, and that responds by coordinating the delivery of the media from the at least one server at the second network protocol address to the first storage at the first network protocol address for consumption by the first television display. More specifically, Nel fails to teach, suggest, or disclose a user interface having at least one user defined media channel, where the at least one user defined media channel comprises a sequence of user selected and scheduled media. Nel is silent with respect to sequences of user-selected media, and is also silent with respect to scheduling, let alone scheduling of media by a user. Nel also fails to teach, suggest, or disclose server software that responds to a request by coordinating delivery of media from at least one server at a second network

protocol address to storage at the first network protocol address for consumption by the first television display. Nel fails to disclose the delivery of media to a storage for consumption by a television display, and instead discloses a system for performing interactive data exchange functions, financial data requests or transactions, commercial transactions or functions, service provider data requests or functions, and communication data requests or functions. (see, e.g., Abstract, paras. [0001]-[0002], [0033], [0048], [0050], [0052], [0054])

Therefore, for at least the above stated reasons, the Applicant respectfully submits that Nel is different from, and fails to anticipate, the Applicant's invention as set forth in claim 1. The Applicant believes that claim 1 is allowable over Nel. Because claims 2-11 depend from claim 1, Nel is different from and fails to anticipate claims 2-11, as well. Therefore, the Applicant respectfully submits that claims 2-11 are also allowable over the Nel reference. The Applicants respectfully request that the rejection of claims 1-11 under 35 U.S.C. §102(a), be withdrawn.

Regarding claim 12, the Applicant respectfully submits that Nel does not teach, suggest, or disclose, for example, a system providing billing support for the exchange of media, the system comprising a first storage in the first home, the first storage supporting media consumption, and having an associated first protocol address; a second television display in a second home, and having an associated second protocol address; a user interface, at the first home, having at least one user defined media channel, each of the at least one user defined media channel comprising a sequence of user selected and

scheduled media, the user interface supporting selection and scheduling of the media; at least one server storing the media; and server software that receives from the first home at the associated first protocol address, via a communication network, a request for the delivery of the media, the request comprising information securing payment for delivery, and that responds by coordinating the delivery of the media from one of the first storage and the at least one server to the second television display at the associated second protocol address for consumption. More specifically, Nel fails to teach, suggest, or disclose storage in a home, where the storage supports media consumption and has an associated protocol address. Nel fails to teach, suggest or disclose a user interface having at least one user defined media channel comprising a sequence of user selected and scheduled media. In addition, Nel is silent with respect to sequences of user-selected media, and is also silent with respect to scheduling, let alone the scheduling of sequences of media by a user. Nel also fails to teach or suggest anything with respect to receiving a request from a first home for delivery of media to a second home, and the delivery of media from a storage in the first home to the second home. Instead, Nel teaches a system for performing interactive data exchange functions, financial data requests or transactions, commercial transactions or functions, service provider data requests or functions, and communication data requests or functions. (see, e.g., Abstract, paras. [0001]-[0002], [0033], [0048], [0050], [0052], [0054])

Therefore, for at least the above stated reasons, the Applicant respectfully submits that Nel is different from and fails to anticipate the Applicant's invention as set forth in claim 12. The Applicant believes that claim 12 is allowable over Nel. Because claims 13-22 depend from claim 12, Nel is different from and fails to anticipate claims 13-22, as well.



Therefore, the Applicant respectfully submits that claims 13-22 are also allowable over the Nel reference. The Applicant respectfully requests that the rejection of claims 12-22 under 35 U.S.C. §102(a), be withdrawn.

Regarding claim 23, the Applicant respectfully submits that Nel does not teach, suggest, or disclose, for example, a system providing billing support for the exchange of media, the system comprising a first storage in the first home; a second television display in a second home; a user interface having at least one user defined media channel comprising a sequence of user selected and scheduled media, the user interface supporting selection and scheduling of the media; at least one server storing the media; and server software that receives a request for the delivery of the media, the request comprising information securing payment for delivery, and that responds by coordinating the delivery of the media from one of the first storage and the at least one server to the second television display for consumption. More specifically, Nel fails to teach, suggest or disclose a user interface having at least one user defined media channel, and a user defined media channel comprising a sequence of user selected and scheduled media. Nel is silent with respect to sequences of user-selected media, and is also silent with respect to scheduling, let alone the scheduling of media by a user. Nel fails to teach anything about a server storing media, and is silent with respect to server software. Nel also fails to teach, suggest, or disclose server software receiving requests for media from storage in a first home for delivery to a second home, and the delivery of media from a storage in a home or from a server. Instead, Nel teaches a system for performing

interactive data exchange functions, financial data requests or transactions, commercial transactions or functions, service provider data requests or functions, and communication data requests or functions. (see, e.g., Abstract, paras. [0001]-[0002], [0033], [0048], [0050], [0052], [0054])

Therefore, for at least the above stated reasons, the Applicant respectfully submits that Nel is different from and fails to anticipate the Applicant's invention as set forth in claim 23. The Applicant believes that claim 23 is allowable over Nel. Because claims 24-28 depend from claim 23, Nel is different from and fails to anticipate claims 24-28, as well. Therefore, the Applicant respectfully submits that claims 23-28 are also allowable over the Nel reference. The Applicant respectfully requests that the rejection of claims 23-28 under 35 U.S.C. §102(a), be withdrawn.

The Applicant also reserves the right to argue additional reasons beyond those set forth above to support the allowability of claims 1-39.

**CONCLUSION**

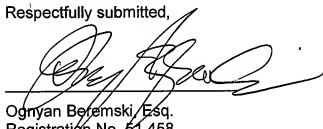
Based on at least the foregoing, the Applicant believes that all claims 1-39 are in condition for allowance. If the Examiner disagrees, the Applicant respectfully requests a telephone interview, and request that the Examiner telephone the undersigned Attorney at (312) 775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

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Ognyan Beremski, Esq.  
Registration No. 51,458  
Attorney for Applicant

MCANDREWS, HELD & MALLOY, LTD.  
500 WEST MADISON STREET, 34TH FLOOR  
CHICAGO, ILLINOIS 60661  
(312) 775-8000

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